

REMARKS

Examination on the merits is respectfully requested in light of the foregoing amendments and following remarks.

1. Status of the Claims

Claims 1-46 stand pending and are subject to a restriction/election requirement. Applicants amend claim 29 to correct a prior typographic error. In addition, Applicants amend claim 16 to more precisely recite the claimed subject matter. No prohibited new matter is believed to have been introduced by way of the amendment.

2. Support for the Amendment

Support for the amendment to claim 29 can be found at least, for example, in the claims as originally filed. Similarly, support for the amendment to claim 16 can be found at least, for example, in Reference Example 1 on pages 17-18 of the Specification. The amendments accordingly do not enter impermissible new matter.

3. Revocation and New Power of Attorney – Change of Correspondence

Please note that the undersigned has taken over the instant application. Please make sure PAIR is updated to denote the change with the Revocation and New Power of Attorney that is being filed with the instant response.

4. Response to Restriction

The Office restricted claims 1-46 in to one of the following groups:

Group I, claims 1-15 and 32-46, drawn to an agent or composition having an effect of preventing or ameliorating liver diseases associated with hepatopathy; or

Group II, claims 16 and 32-46, drawn to a method of preparing ingest having an effect of preventing or ameliorating liver diseases associated with hepatopathy; or

Group III, claims 17-31 and 32-46, drawn to a method of preventing or ameliorating liver diseases associated with hepatopathy.

5. Election with Traverse

Applicants elect **Group III**, claims 17-31 and 32-46 with traverse. Traverse is on the following grounds:

5.1 The Office fails to address burden of search

Applicants respectfully traverse the Restriction/Election Requirement, because the Office fails to address the burden of search after the International Search Report fails to observe that the unity of invention is lacking. In the present case, there is an increased burden above the already “serious burden” in evincing why a restriction requirement is necessary, especially given as the International Searching Authority has already performed a search on all the claims. *See* Anthony Caputa, “Two Be or Not To Be: or Divide and Conquer: or A Case Divided Cannot Stand: Principles in Restriction Practice TC 1600,” presented December 2004 to the Customer Partnership Meeting, *available at* www.uspto.gov/web/patents/tc1600restrictionmaterials.pdf. The burden of search, however, was nowhere mentioned in the Restriction/Election Requirement. Accordingly, Applicants respectfully request the Office reconsider and withdraw the Restriction/Election Requirement.

5.2 The restriction requirement should be reconsidered in light of the present amendment

Upon entry of the amendments, claim 16 recites a process specially adapted for the manufacture of claimed composition. Accordingly, Groups I and II claims should be examined in the same application under the procedures for examination of a national stage application set forth in 37 C.F.R. § 1.475.

We note that we have amended claim 16, even though this is not part of the elected Group III.

5.3 The reasons set forth above justify reconsideration and withdrawal of the restriction requirement, irrespective of unity of invention

The Office alleges that U.S. Patent No. 5,320,846 destroys a special technical feature that otherwise would united the claims. Applicants request that the reference be used in a statutory rejection instead, so that Applicants can respond appropriately to the Office's allegation. The Office does not possess unfettered discretion to restrict the claims, even when a reference allegedly teaches a technical feature that otherwise would destroy unity of invention. *See* M.P.E.P. § 1850. Irrespective of the procedures in M.P.E.P. § 1850, however, the Office should reconsider and withdraw the restriction requirement for the reason set forth above.

CONCLUSION

Should the Examiner have any questions or comments regarding Applicants' amendments or response, she is asked to contact Applicants' undersigned representative at (202) 842-8821. Please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number.

Respectfully Submitted,

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